

Docket No.: J&R 0190 US/P

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July 17, 2002
Date

UNITED STATES IN THE PATENT AND TRADEMARK OFFICE

Applicant : Angelika Semsch et al.
Applic. No. : 08/930,735
Filed : September 29, 1997
Title : Device for Preventing or Reducing Tipping of the Head
Attention : PCT Legal Office

RENEWED PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Hon. Commissioner of Patents and Trademarks,
Washington, D. C. 20231

Sir:

1 This is in response to a Decision received from the PCT Legal Office with a date of July 2, 2002. The Decision by the Office issued nearly four years after applicants had filed a first petition, which was followed by several further items of communication requesting action by the Office.

2 The Decision dealt with two issues. First, the Office had accorded the instant application an incorrect filing date. The Decision agreed with applicants and stated that the Office would accord this application the correct filing date of September 29, 1997. Second, the Decision maintains the holding of abandonment even though applicants have clearly shown that the abandonment should be rescinded. Applicants herewith request that the second issue be revisited and that the application be returned to regular pending status.

j The Decision is in error for at least two reasons and applicants are clearly entitled to further prosecute the PCT application in the national stage in the United States. Please consider the following:

35 U.S.C. § 371 requires, *inter alia*, the submission of the national fee. If, according to § 371 the "requirements with respect to the national fee . . . [are not] complied with by the date of the commencement of the national stage . . . [a later time limit] may be fixed by the Director." The expression "fixed by the Director" has been interpreted in the context of national applications in the United States as an invitation to be sent from the Office to the applicants in the form of a Notice to File Missing Parts (PTOL 1533 in applications under § 111) or a Notification of Missing Requirements (Form PCT/DO/EO/905 in applications under § 371).

j The Office indeed set a later time limit in the instant application by issuing the Notification of Missing Requirements on December 10, 1997. The Notification contained a statement that the originally submitted fee was insufficient on its face because no verified small entity declaration had been filed. Further, the Notification invited applicants to submit a signed oath or declaration and the surcharge for filing the declaration and/or the complete national stage fee after the expiration of the date of the commencement of the national stage. The Office set a usual one-month date for response to the Notification. Applicants responded by submitting a signed declaration and a properly executed verified small entity declaration. No further payment was submitted at that time because the Notification of December 10, 1997 stated that counsel's deposit account would be charged for the additional filing fee.

In light of the statement that counsel's deposit account would be charged, applicants took no further action with regard to the apparently incomplete filing fee.

6 Furthermore, in light of the submission of the verified small entity declaration, counsel was justified to presume that the filing fee would be retroactively considered sufficient. Logic and proper business practice dictates that even though the verified small entity declaration was not originally submitted but then submitted at a later point and the additional fees had not yet been charged, the Office would abstain from in fact charging the large entity amounts. Counsel knows of no rule or statute that would prevent the Office from actually applying such logic and business practice.

1 The Decision, on page 3 thereof, goes on to state that "applicants could not have detrimentally relied on a statement that the large entity fee would be charged" because, allegedly, the application was already abandoned as of the commencement date. This is completely wrong. If the time limit for entering the national stage with regard to the United States is missed for whatever reason and the failure to take the necessary steps or the proper steps is based on an inadvertent error and the delay is unintentional, applicants have one year from the end of the 20-month PCT period to refile the application as a Bypass Continuation (35 U.S.C. § 111) or as a national stage (§ 371) with a Petition to Revive under 37 CFR 1.137(b), together with the regular 35 U.S.C. § 111 filing fee or the national stage filing fee. Had the Office not stated that the large entity amount would be charged to the deposit account, applicant would have had approximately eight months within which to file the petition under Rule 137(b). This is indeed detrimental reliance on official action by a government agency. The fact that the Decision issued nearly four years late, is entirely the fault of the Office and to foreclose applicants' chances of bringing this application into proper form would certainly fly in the face of all equitable principles.

4 When faced with the option of relying on the statement that the additional fee would be charged and paying the surcharge of \$65.00 as opposed to a refiling with the 35 U.S.C. § 111 filing fee and a Petition under Rule 137 and paying more than \$600.00, it was clear that the former option would be chosen. On being properly or timely instructed or instructed differently, applicants could have and would have taken whatever steps necessary to keep the application alive.

9 The PCT Legal Office is therefore requested to objectively consider what has taken place here. Upon receiving the Notice dated December 10, 1997, counsel had the opportunity to correct the deficient filing fee in two possible ways. Counsel could respond to the Notice as was done, or refile a Bypass Continuation and a Petition to Revive. Counsel was well aware of the latter procedure having done so several times in other cases where the 20 or 30-month period had expired. After responding to the Notice timely on January 12, 1998, counsel had no reason to suspect that there was any problem with this application. However, when first told of a problem by the Patent Office in the Communication dated November 23, 1998 (after reminders by counsel), it was then too late for filing the Bypass Continuation. Therefore, it is

solely through the action of the Office that counsel has been lulled into thinking that there was no problem until it was too late to take alternative action. Had counsel been informed of a problem instead of being sent the Notice of December 10, 1997 or been told of a problem within a reasonable time (even after reminders), the Bypass Continuation would have still been viable. Instead, the first sign of a problem was first expressed nearly two months after the period for filing a Bypass Continuation had expired.

The Decision states that the box was not checked next to the authorization statement that counsel's deposit account should be charged, even though the deposit account number was entered in that statement. The original statement in the Notification of December 10, 1997 shows that the Office did understand applicants' intention that the deposit account should be charged for any fee deficiencies. The Decision is at complete odds with the earlier notification and the Decision does not cite any statute, any rule, or any other published notice which would support holding either one way or the other way. Accordingly, the conclusion by the PCT Legal Office is entirely capricious and cannot, without more, be accepted by applicants.

In summary, the petition should be granted for several reasons, including:

1) 35 U.S.C. § 371 invites the Director to set a date for later submission if any of several items are not filed at the date of commencement of the national stage. In this case, the Office sent an invitation that applicants submit the signed declaration and stated that an additional fee would be charged.

2) Applicants relied detrimentally on the statement in the Notification. The application -- if it was indeed abandoned as of the date of commencement -- was eminently curable for approximately eight months following the receipt of the Notification.

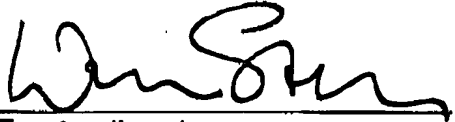
3) The presence of counsel's Deposit Account number shows a clear intention to charge any additional fees due. This is counsel's regular practice.

In closing, counsel points out that in a communication and notification of abandonment dated November 23, 1998 the Office "vacated" the Notification of

Missing Requirements. The PCT Legal Office is requested to reinstate the Notification, because it was vacated based on the incorrectly assigned filing date.

In view of the foregoing, the Office is requested to expedite this Renewed Petition and to reinstate this application to regular pending status at the earliest possible time.

Respectfully submitted,



For Applicants

WERNER H. STEMER
REG. NO. 34,956

Date: July 17, 2002

Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101

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